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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/753,248

01/08/2004

David T. Green

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6754

50855

7590

01/26/2009

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EXAMINER

NASH, BRIAN D

ART UNIT

PAPER NUMBER

3721

MAIL DATE

DELIVERY MODE

01/26/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/753,248	Applicant(s) GREEN ET AL.	
	Examiner Brian Nash	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner's Comments

1. This action is in response to applicant's amendment received 10/31/2008. The pending claims are now 2-8.
2. The Examiner notes that the office action below may reference support found in the cited prior art by indicating element numbers, figures or by pointing out a specific paragraph (PAR) number in which support can be found. The PAR number referenced corresponds to paragraph number beginning in the "Detailed Description" of the disclosure unless otherwise noted.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 2-8 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,728,020 to Green et al. Green et al shows the same apparatus for applying surgical fasteners.

With respect to claims 2 and 8, an elongate member (100) defining a longitudinal axis (102), a staple storage portion (280) attached to a distal portion of the elongate member and being movable between two positions with respect to the longitudinal axis defined by the elongate member, a control member capable of rotating the elongate member about the longitudinal axis (lock ring 190, fig. 1, i.e. 190 controls whether shaft member 100 can rotate between a plurality of positions about axis 102), an advancing mechanism (70) capable of advancing surgical fasteners through the staple storage portion and an anvil (290).

With respect to claim 3, the apparatus having a frame and handle assembly (20, fig. 1), the assembly has a stationary member and a pivotal member (70).

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With respect to claims 4 and 5, the apparatus of Green et al discharges surgical fasteners when the handle member (70) is squeezed by an operator, i.e. pivotal member pivots between positions. The Examiner further notes that handle member can be partially pivoted or fully pivoted, i.e. moved from a first to a second position.

With respect to claims 6 and 7, the staple storage portion (280) includes a staple cartridge (210) removably attached to the staple support member.

Response to Arguments

5. *In re* claim 2, applicant's arguments filed 10/31/2008 have been fully considered but they are not persuasive. Applicant contends, *inter alia*, that Green does not perform the same function as the claimed invention. Examiner acknowledges applicant's position; however, a reference is deemed to properly anticipate a claim when all the recited limitations are disclosed therein. In this instance, Green shows all the recited structural limitations including a control member (lock ring 190) that can be moved between a first and second position (unlocked and locked position) and that moving the control member (i.e. an operator grasping the device by the control member 190) can rotate the end effector (i.e. the staple storage portion) about the longitudinal axis. While it is noted that the device of Green may not perform the same function or in the same manner as applicant's invention, it is deemed that the claims are not restrictive to such device. Specifically, movement of the staple storage portion and/or rotation of the staple storage portion about the longitudinal axis has not been claimed as with respect to the proximal (handle portion) end of the stapler and therefore rotation of the entire stapler about the longitudinal axis anticipates the claim. For the reasons above, the grounds for rejection are deemed proper.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is 571-272-4465. The examiner can normally be reached on Monday – Friday from 8 a.m. to 4 p.m.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 571-272-4467. The official fax number for this Group is: 571-273-8300

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. For more information about the PAIR system, see www.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Brian D. Nash/
Primary Examiner, Art Unit 3721

1/16/2009